



UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, Virginia 22313-1450  
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/752,426	01/06/2004	Waldeman Priebe	PSPS:004USC1

32425  
FULBRIGHT & JAWORSKI L.L.P.  
600 CONGRESS AVE.  
SUITE 2400  
AUSTIN, TX 78701



CONFIRMATION NO. 3793  
FORMALITIES LETTER



\*OC000000012166713\*

Date Mailed: 03/23/2004

**NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION**

08/17/2004 BABRAHA1 00000048 10752426

01 FC:2001 385.00 OP  
02 FC:2051 65.00 OP

**FILED UNDER 37 CFR 1.53(b)**

*Filing Date Granted*

**Items Required To Avoid Abandonment:**

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.  
*Applicant must submit \$ 385 to complete the basic filing fee for a small entity.*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.

The applicant needs to satisfy supplemental fees problems indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Additional claim fees of **\$759** as a small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

**SUMMARY OF FEES DUE:**

Total additional fee(s) required for this application is **\$1209** for a Small Entity

- **\$385** Statutory basic filing fee.
- **\$65** Late oath or declaration Surcharge.
- Total additional claim fee(s) for this application is **\$759**

- \$516 for 12 independent claims over 3.
- \$243 for 27 total claims over 20.

Replies should be mailed to: Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

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*A copy of this notice MUST be returned with the reply.*

B. Hablow

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/752,426	01/06/2004	Waldeman Priebe	PSPS:004USC1

32425

FULBRIGHT & JAWORSKI L.L.P.  
 600 CONGRESS AVE.  
 SUITE 2400  
 AUSTIN, TX 78701



CONFIRMATION NO. 3793



\*OC000000012166735\*

Date Mailed: 03/23/2004

## Notice Regarding Benefit/Priority Claim(s)

### ☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

### ☐ Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant application was not filed within twelve (12) months from the filing date of the provisional application,

and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed with 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

☐ **Improper Priority Claim(s) to Prior-Filed Foreign Application(s)**

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

**Timeliness:** The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

☐ **Benefit Claims to More Than 400 Prior-Filed Applications**

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.



**Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35**

**U.S.C. 371) Application**

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application.

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/week11/patbene.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

PART 2 - COPY TO BE RETURNED WITH RESPONSE



**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Waldemar Priebe et al.

Serial No.: 10/752,426

Filed: January 6, 2004

For: METHODS AND COMPOSITIONS FOR  
THE MANUFACTURE OF C-3' AND C-4'  
ANTHRACYCLINE ANTIBIOTICS

Group Art Unit: 1623

Examiner: Unknown

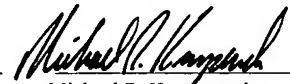
Atty. Dkt. No.: PSPS:004USC1

CERTIFICATE OF MAILING  
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: MS MISSING PARTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

August 12, 2004

Date

  
Michael R. Krawzensenk

**RESPONSE TO NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL  
APPLICATION FILED UNDER 37 CFR 1.53(B)**

**MS MISSING PARTS**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In response to the Notice to File Missing Parts of Nonprovisional Application filed under 37 CFR 1.53(b), dated March 23, 2004, enclosed are:

- (a) Preliminary Amendment;
- (b) Our check in the amount of \$450.00 to cover the basic filing fee (\$385.00 - utility small entity); surcharge for late filing (\$65.00);
- (c) Our check in the amount of \$475.00 to cover the three month extension of time;

- (d) A copy of Notice to File Missing Parts of Nonprovisional Application filed under 37 CFR 1.53(b); and
- (e) A Request for Extension of Time of three months to and including August 23, 2004. Should such request be absent, consider this such a request and authorization to withdraw the appropriate fee under 37 C.F.R. §§ 1.16 to 1.21 as stated below.

If the check is inadvertently omitted, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included herein, the Commissioner is authorized to deduct or credit said fees from or to Fulbright & Jaworski Deposit Account No.: 50-1212/PSPS:004USC1.

Please date stamp and return the accompanying postcard to evidence receipt of these documents.

Respectfully submitted,



Michael R. Krawzsenek  
Reg. No. 51,898  
Attorney for Applicants

FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201

Date: August 12, 2004



## FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP  
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WWW.FULBRIGHT.COM

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DIRECT DIAL: (512) 536-3020

TELEPHONE: (512) 474-5201  
FACSIMILE: (512) 536-4598

August 12, 2004

### CERTIFICATE OF MAILING 37 C.F.R. 1.8

I certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: MS MISSING PARTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

August 12, 2004

Date

Michael R. Krawzsenek

### MS MISSING PARTS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

RE: *U.S. Patent Application No. 10/752,426 entitled "METHODS AND COMPOSITIONS FOR THE MANUFACTURE OF C-3' AND C-4' ANTHRACYCLINE ANTIBIOTICS" – Waldemar Priebe et al.*  
*Our reference: PSPS:004USC1*

Sir:

Please find enclosed:

- (1) A Response to Notice to File Missing Parts of Nonprovisional Application filed under 37 C.F.R. 1.53(b) mailed March 23, 2004;
- (2) Preliminary Amendment;
- (3) Request for Extension of Time;
- (4) Copy of Notice to File Missing Parts of Nonprovisional Application filed under 37 C.F.R. 1.53(b)-Filing Date Granted;
- (5) Checks in the amount of \$450.00 and \$475.00; and
- (6) A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

25417408.1



Commissioner for Patents  
August 12, 2004  
Page 2

If the check is inadvertently omitted, or the amount is insufficient, or should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, or should an overpayment be included, the Commissioner is authorized to deduct or credit the appropriate fees from or to Fulbright & Jaworski Deposit Account No.: 50-1212/PSPS:004USC1.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael R. Krawzsenek". The signature is fluid and cursive, with the first name "Michael" being the most prominent part.

Michael R. Krawzsenek  
Reg. No. 51,898

MRK/mar  
Encl: as noted